APPENDIX

CONTAINING REVISED STATUTES 4886 AND 4887

being respectively

Secs. 31 and 32 of Title 35, U. S. C.

and

TRADING WITH THE ENEMY ACT, TITLE 50 U. S. C., SECTION 10, SUBDIVISION (g)

TOGETHER WITH CLAIMS 1 AND 2 OF U. S. PATENT 1,584,149; CLAIMS 1, 2, 3, 9, 11 AND 12 OF U. S. PATENT 1,584,150; AND CLAIMS 1, 2 AND 3 OF JAPANESE PATENT 42,563;

and also

EXCERPT FROM DEFENDANT'S BRIEF BEFORE CIRCUIT COURT OF APPEALS ON SECOND APPEAL, AT PP. 24, 25.

APPENDIX

Containing Revised Statutes 4886 and 4887

Being Respectively

§§ 31 and 32 of Title 35, U. S. C.

R. S. 4886:

"Section 31. *Inventions patentable.* Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others *in this country,* before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (R. S. § 4886; Mar. 3, 1897, c. 391, § 1, 29 Stat. 692.)"

R. S. 4887:

"§ 32. *Inventions previously patented abroad.* No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section 31 of this title, and four months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

"An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section 31 of this title, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing. (R. S. § 4887; Mar. 3, 1897, c. 391, § 3, 29 Stat. 693; Mar. 3, 1903, c. 1019, § 1, 32 Stat. 1225.)"

Claims of U. S. Patent 1,584,149

"1. A method of forming a finely divided chemically reactive lead powder of such fineness and activity as to be readily changed chemically on contact with air, which comprises introducing relatively large masses of lead into a rotatable vessel, rotating said vessel at a relatively low speed and forming said lead powder by attrition of said lead masses resulting from the rubbing of said masses against each other.

"2. A method of forming a finely divided chemically reactive lead powder of such fineness and ac-

tivity as to be readily changed chemically on exposure to air, which comprises introducing relatively large masses of lead into a rotatable vessel, rotating said vessel at a relatively low speed, introducing a current of air into said vessel, forming said lead powder by attrition of said lead masses resulting from the rubbing of said lead masses against each other, and removing the said powder from said vessel by means of said current of air." (R. III, 1222.)

Claims of U. S. Patent 1,584,150

"1. A process of manufacturing a fine powder of lead suboxide intermingled with powder of metallic lead, comprising in putting pieces of metallic lead in a rotatable vessel in a dry state, introducing into the said vessel currents of an oxidizing gas to oxidize the surface of the lead while rotating the said vessel, and abrading off the oxide formed on the surface."

"2. A process of manufacturing a fine powder of lead suboxide intermingled with powder of metallic lead, comprising in putting in a rotatable vessel pieces of metallic lead in a dry state, introducing into the said vessel while rotating blasts of a gas containing oxygen, such as air, causing such blast to blow the powder produced out of the vessel."

"3. A process of manufacturing a fine powder of lead suboxide intermingled with powder of metallic lead comprising in putting pieces of metallic lead in a dry state into a rotatable vessel, and delivering an oxidizing gas into the vessel while revolving the same."

"9. A method of forming a finely divided powder containing a large proportion of oxidized lead which comprises impinging a current of air on lead masses in a dry state, abrading the lead masses, and controlling the temperature to obtain a finely divided powder containing a large proportion of oxidized lead."

"11. A method of forming a finely divided powder containing a large proportion of oxidized lead which comprises impinging a current of air on lead masses in a dry state, abrading the lead masses, and controlling the current of air to obtain a finely divided powder, containing a large proportion of oxidized lead."

"12. A method of forning a finely divided powder containing a large proportion of oxidized lead comprising impinging a current of air on lead masses in a dry state, abrading the lead masses, and controlling the temperature and current of air to obtain a finely divided povder containing a large proportion of oxidized lead." (R. III, 1224, 1225.)

Claims of Japanese Patent 42,563

"(1) In order to achieve the object recorded earlier in this record, a method of manufacturing chemically reactive lead powder is claimed, a special feature of which is throwing lumps of lead into a rotating vessel, and blowing currents of air or other inactive gases into the vessel during rotation to force the small particles produced by rubbing out of the vessel."

"(2) In order to achieve the purpose recorded above, a method of manufacturing chemically reactive lead powder is claimed, as stated in the previous paragraph, which governs the size of the particles by means of the velocity of currents of inblowing air."

"(3) In order to achieve the purpose recorded above, a method of manufacturing chemically reactive lead powder is claimed as stated in the preceding paragraphs, which provides for continuously or periodically supplying raw material in the form of lumps of lead at a given rate, and blowing out the finished particles by the force of the wind so that the work is done continuously." (R. III, 1253, 1254.)

Trading with the Enemy Act, Title 50 U. S. C., Section 10, subdivision (g)

"Any enemy, or ally of enemy, may institute and prosecute suits in equity against any person other than a licensee under this act to enjoin infringement of letters patent, trade-mark, print, label, and copyrights in the United States owned or controlled by said enemy or ally of enemy, in the same manner and to the extent that he would be entitled so to do if the United States was not at war; Provided, That no final judgment or decree shall be entered in favor of such enemy or ally of the enemy by any court except after thirty days' notice to the alien property custodian. Such notice shall be in writing and shall be served in the same manner as civil process of Federal Courts."

Excerpt From Defendant's Brief Before Circuit Court of Appeals on Second Appeal at pp. 24-25

"I-B.

BOTH CLAIMS OF PATENT NO. 1,584,149 ARE INVALID FOR WANT OF UTILITY.

In its original opinion, the District Court said:

> 'It was demonstrated conclusively both by witnesses at this trial and by Ishimura in the course of his efforts to develop the process, that, if lead balls are rumbled together in an inert atmosphere, the result will be nil. The balls will simply polish one another and not an ounce of powder will result.'

The witnesses for the respective parties are in accord as to that.

Since the employment of an oxidizing temperature and an oxidizing agent are indispensable *steps*

in the production of powder, and since Shimadzu used neither in patent 41,728, in Patent 42,563 or in Patent '149,—it is clear that these patents are all without utility.

Indeed, plaintiffs, in their brief, assert that 41,728 and 42,563 are both inoperable, and as '149 is for the same invention as those two patents, it would seem self-evident that '149 is likewise and equally inoperable.

Were some theory found under which Japanese Patent 41,728 could be said to be operable, Claim 1 of '149 would be operable for the same reason, but invalid under R. S. 4887. Were 42,563 deemed operable under some theory, the like theory would make Claim 2 of '149 operable, but invalid nonetheless under R. S. 4887." (Italics not ours)